

REMARKS/ARGUMENTS

Claims 1-17, 20-21, 23-24, and 37-38 are cancelled; Claim 40 is amended.

Amended Claim 40 is supported, for example, at previously presented Claim 40.

No new matter is added.

Present Claim 18 is drawn to a method of reducing at least one skin damage in a subject in need thereof. The method comprises comprising orally administering to the subject in need thereof a composition comprising diacylglyceryl ether represented by the formula (I), triglyceride, and squalene, in an amount sufficient to reduce the at least one skin damage. The at least one skin damage is selected from the group consisting of formation of skin cancer induced by ultraviolet light, formation of pigmented spots induced by ultraviolet light, formation of freckles induced by ultraviolet light, the formation of wrinkles induced by ultraviolet light, the formation of verrucae induced by ultraviolet light, and the formation of erythema induced by ultraviolet light.

The obviousness rejection of Claims 18-19, 22, 25-26, and 39-41 as being unpatentable in view of Brohuit and Ecomer is traversed.

At the outset, the Office, at pages 3-4 of the Official Action, concerning product by process Claims 40 and 41, describes “the claim limitations are considered to be product by process limitations” and that “the process from which [the product] is made does not hold patentable weight.” Applicants respectfully submit the Office’s reasoning is flawed. Present Claims 40 and 41, for example, contain the features that the shark liver oil is prepared by a process comprising “subjecting the shark liver oil to degumming and deacidification treatment and vacuum distillation to obtain an intermediate product, and decolorizing and steam distilling, with active clay, the intermediate product to obtain the composition.” Accordingly, in present Claim 40, raw shark liver oil is degummed. Specification page 8, lines 14-15, describe “[s]hark liver oil was subjected to degumming and deacidification

treatment and vacuum distillation so as to remove hydrocarbon components.” Thus, the process features of present Claims 40 and 41 alter shark oil by at least degumming it and removing hydrocarbon components. The Office has not shown that either Brohuit or Ecomer contain the process features of present Claims 40 and 41. The Office has further not shown that either Brohuit or Ecomer describe or suggest a purified shark oil that is at least both degummed and has hydrocarbons removed. The Office’s case for obviousness is therefore improper because the Office has not made a showing that the cited references describe or suggest all of the features of present Claims 40 and 41. Further, Applicants submit that neither Brohuit or Ecomer describe or suggest all of the features of present Claims 40 and 41. Withdrawal of the obviousness rejection is requested for these claims.

The obviousness rejection of Claims 18-19, 22, 25-26, and 39-41 is traversed because the references, either alone or in combination, do not describe or suggest all of the features of present Claim 18 and the claims depending therefrom. As described, *supra*, present Claim 18 is drawn to a method of reducing at least one skin damage, from the list of skin damages defined in the claim, in a subject in need thereof. The Office, at page 4 of the Official Action, describes that “Brohuit does not particularly disclose [the skin damages of present Claim 18]” but reasons “it would have been obvious to one of ordinary skill in the art to have used the composition of Brohuit for the treatment of UV light induced skin damage since it is disclosed that ethers beneficially influence diseases depending upon epidermal growth.” The Office appears to thus be arguing that the skin damages of present Claim 18 are species of the genus of “diseases depending upon epidermal growth” and thus would be obvious. Without affirming the Office’s proposed genus species relationship, Applicants submit that the genus of Brohuit proposed by the Office does not anticipate or render obvious the species of present Claim 18 because a genus does not render obvious a specie or species. Withdrawal of the rejection is requested on this basis alone.

Additionally, present Claim 18 contains, as a feature, that the method is performed on “a subject in need thereof.” The “in need thereof” language used here has been approved by the Federal Circuit for inventions like present Claim 18 where the method requires the specific intent to effect the specific results stated in the preamble of the claim.

The case of Jansen v. Rexall Sundown Inc., 68 U.S.P.Q.2d 1154 (Fed. Cir. 2003) requires that the currently pending prior art rejection be withdrawn. In *Jansen*, the claims were directed to methods of treating or preventing macrocytic-megaloblastic anemia comprising administering effective amounts of folic acid and vitamin B<sub>12</sub> to humans in need thereof. *Jansen* at 1157. In interpreting these claims, the Federal Circuit ruled that the claims require the specific intent to achieve the claimed objective (treatment or prevention of macrocytic-megaloblastic anemia). Specifically, the Federal Circuit stated that:

. . . the claim preamble sets forth the objective of the method, and the body of the claim directs that the method be performed on someone ‘in need.’ In both cases, the claims’ recitation of a patient or a human ‘in need’ gives life and meaning to preambles. [Citation omitted]. The preamble is therefore not merely a statement of effect that may or may not be desired or appreciated. Rather, **it is a statement of the intentional purpose for which the method must be performed.** We need not decide whether we would reach the same conclusion if either of the ‘treating or preventing’ phrase or the ‘to a human in need thereof’ phrase was not a part of the claim; **together, however, they compel the claim construction arrived at by both the district court and this court.**

*Jansen* at 1158 (emphasis added).

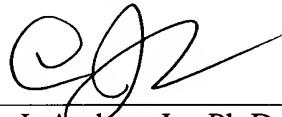
Thus, according to the Federal Circuit, claims directed to methods of treatment to be performed on those in need of such treatment require the specific intent to effect such

treatment. Present Claim 18 is analogous to the claims in Jansen and is directed to a method of reducing at least one skin damage in a subject in need thereof ... (see Claim 18, *supra*). The cited references neither teach nor suggest such specific intent. Put differently, there is nothing in the cited references that would lead one skilled in the art to believe that the composition administered in the method of Claim 18 could be administered for this express purpose of treating the claim enumerated diseases in a person in need thereof. Thus, the cited references cannot render obvious present Claim 18 and the claims depending therefrom. Withdrawal of the obviousness rejection is requested.

Applicants submit the present application is now in condition for allowance. Early notification to this effect is earnestly solicited.

Respectfully submitted,

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